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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,658	01/24/2002	Hiromi Nambu	218360US0	9726

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EXAMINER	
FUBARA, BLESSING M	

ART UNIT	PAPER NUMBER
1618	

NOTIFICATION DATE	DELIVERY MODE
07/03/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/053,658	NAMBU ET AL.	
	Examiner	Art Unit	
	Blessing M. Fubara	1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 March 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-5,7,8,10-22,30-36,41 and 42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-5,7,8,10-22,30-36,41 and 42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Examiner acknowledges receipt of request for extension of time, declaration under 37 CFR 1.132, amendment and remarks, all filed 3/30/2007. Claims 1, 35 and 36 are amended. Claim 29 and 37-40 are canceled. Claims 1, 3-5, 7, 8, 10-22, 30-36, 41 and 42 are pending.

Response to Arguments

Previous rejections that are not reiterated herein are withdrawn.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 3-5, 7, 8, 10-22, 30-36, 41 and 42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is new matter rejection

The as filed specification does not support a gel having viscosity in the range of 500,000 to 20,000,000 mPa.s. The specification provides support for gel having viscosity of 100,000 to 20,000,000 mPa.s in paragraph [0104] of the published application.

This rejection may be overcome by removing the new matter form the claims.

Response to Arguments

3. Applicant's arguments filed 3/30/07 have been fully considered but they are not persuasive.

Applicant argues that a range of viscosity from 500,000 to 20,0000 mPa.s is explicitly disclosed in view of the disclosed 100,000 mPa.s or more, 300,000 mPa.s or more, 500,000 mPa.s or more and upper limit of 20,000,000 mPa.s.

Response:

Single viscosity points of 100,000 mPa.s or more, 300,000 mPa.s or more, 500,000 mPa.s or more and upper limit of 20,000,000 mPa.s do not represent a range of 500,000 to 20,000,000 mPa.s, because there other points such as 600000, 700000, 1,500,000, 10,0000 between the 500,000 to 20,000,000 mPa.s such that the in between points identified above would not be supported without a clear disclosure for a range of 500,000 to 20,000,000 mPa.s,

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1, 3-5, 7, 8, 10-22, 30-36, 41 and 42 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Hori et al. (US 4,830,633).

Hori discloses depilatory composition comprising film forming polymer, depilatory medicine and additives such as alkali agent, hair swelling accelerating agent, a filler, perfume and coloring agent (column 2, lines 3-10). The film forming polymer is selected from the group of polyvinylpyrrolidone, polyacrylamide, polyacrylic acid and salts thereof, polyvinyl alcohol, carboxymethyl cellulose, methyl cellulose, hydroxyethyl cellulose, hydroxypropyl cellulose, gelatin, alginic acid, alginic acid salts, polyethylene glycol, gum arabic, acrylic esters and polyvinyl methyl ether in an amount of 1-70 wt%,' 3-20 wt% depilatory medicine selected from the group of thioglycolic acid or its salts; water; 0.1-5 wt% alkali agents selected from the group of ammonium salt, metal salt of organic dicarboxylic acid, potassium hydroxide, calcium hydroxide and sodium hydroxide; urea as hair swelling accelerating agent; glycerin; dactyl phthalate plasticizer; an silicon dioxide or calcium carbonate or clay or kaolin or aluminum hydroxide (column 2, line 11 to column 3 line 55 and examples 1, 2 and 7 and claims 1, 3, 5, 6, and 8-10). The composition has a viscosity of from 0.1 to 1,000 poise at 30 °C (column 2, line 53). The composition is applied to underarm and allowed to stand for 15 minutes (example 7) and 10 minutes (example 9) and 8 minutes (example 10). Since Hori teaches the same amount of cross-linking agent (calcium hydroxide) and same amounts of hydrophilic polymer as in the instant claim, it is inherent that the depilatory composition of the prior art, Hori would have the same equivalents of cross-linking agent to ionic group of the hydrophilic polymer as recited in instant claim 19. The process of instant claim 20 applies the composition to an area that requires depilation and the process disclosed in Hori meets that limitation. Hori further discloses homo- or and copolymers of acrylic acid or methacrylic acid esters in claim 4. The polymers of Hori meet the limitations of the polymers in claims 14-16; calcium hydroxide (Example 6) meets

claim 17. Regarding claim 22, it is noted that hair grows on the faces of animal subjects and is one of the obvious areas whose unwanted hair is depilated. Non-woven fabrics, paper, cloth, and foamed sheets serve as support material for the gel (column 4, lines 22-30), the gel support of the sheet is heated after application on the area needing depilation (column 4, lines 53-59); the gel is peeled off (column 4, lines 8-19) meeting the method claims 20, 36.

Claims 41 and 42 require the support to be non-moisture-permeable and sparingly moisture permeable respectively and it flows form these limitations recited in these claims that the moisture permeability of the support provides no unusual properties or functions or unexpected results to the gel composition and thus provides that moisture permeable support or sparingly moisture permeable support or non-moisture-permeable support does not provide unexpected results to the depilatory gel composition. In the instant case, Hori's supported gel composition provides the same effect as the instant composition.

Therefore, Hori discloses that a sheet material made of plastic film or paper, non-woven fabric and cloth having a thickness of about 5 to 100 μm (column 3, lines 50-56), hydrophilic non-woven fabric, foamed sheets (column 4, lines 22-31), (meth)acrylonitrile and maleic anhydride graft (column 4, lines 41-68) can be placed over the film or coated with the film for removing hair without leaving residue. Therefore, Hori contemplates the use of a sheet having the composition of the type taught by the instant claims.

Hori differs form the instant claim in the viscosity of the Hori gel is from 0.1 to 1,000 poise at 30 °C (column 2, line 53), which is from 10 mPa.s to 100,000 mPa.s or a preferred viscosity of 0.2 to 100 poise (20 mPa.s to 10,000 mPa.s), while the claimed viscosity is 300,000 mPa.s. Hori contemplates a 10,000 fold increase from going from 10 mPa.s to 100,000 mPa.s or

500 fold increase from going from 20 mPa.s to 10,000 mPa.s for the preferred range. Further, the claimed viscosity is three times the viscosity of the Hori gel at the upper end. Gleaning from applicant' s specification, a range of viscosity from 100,000 to 20,000,000 mPa.s (page 7, right column, lines 4 and 5 of the published application) is contemplated, which is a 200 fold from going from 100,000 to 20,000,000 mPa.s.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the gel formulation of Hori, having a viscosity in the range of 10 mPa.s to 100,000 mPa.s in the method of Hori to remove hair. One having ordinary skill in the art would have been motivated to use a gel formulation to remove hair where the gel composition has a viscosity that is 10,000 or 500 fold the viscosity of the Hori gel at about between 100,000 and 1,000,000,000 mPa.s or 10,000 to 5,000,000 mPa.s preferred, with the expectation that the gel would effectively remove hair. The upper limits of the general range and the preferred range are greater that the recited 500,000 mPa.s as in claim 1 and 5,000,000 lies within the range recited in claim 1. In the absence of factual evidence, a gel having a viscosity of 500,000 mPa.s is not inventive over a gel having a viscosity of 100,000 mPa.s and which may be increased 500 or 10,000 fold.

Response to Argument

6. Applicant's arguments filed 8/31/06 have been fully considered but they are not persuasive.

Applicant argues that it cannot be possible to increase the maximum viscosity of Hori from 100,000 to 500,000 and that the comparable examples 1 and 2 of the instant specification

show that using a composition having a viscosity of 100,000 mPa.s and including 10,000 and 50,000 mPa.s provides significantly inferior results

Response:

Providing "significantly inferior results" is a relative and the comparable acceptable standard was not stated. Regarding increasing the viscosity form 100,000 to 500,000, it is noted that the claimed viscosity is a range indicating that the viscosity can change several folds within the limits of the range, and the broad range of 500,000 to 20,000,000 if the claims represents a 40-fold increase from the minimum to the upper point. Hori also discloses a broad range of 10 to 100,000 representing a 10,000 fold increase. Thus in view of this broad range the viscosity can be optimized to obtain the desired gel. Secondly, the claims do not recite the temperature at which the gel has the range of viscosities and since viscosities are temperature dependent, decreasing with increasing temperature, the Hori viscosity at 30 °C is expected to be higher at say, 25 °C. The viscosities on shown on Table 1 are 10000000, 5000000, 1000000, 8000000, 7,000000, 3000000 and 1000000 show good application and adhesiveness, while viscosities of 10,000, 5000 and 30000000 show difficult application and adhesiveness. The table has no data for viscosity of 100000. Therefore, Table 1 does not provide data for viscosity of 100,000. Furthermore, the data on Table 1 uses 5% thioglycolic acid while the claimed composition does not provide the concentration of the glycolic acid, so that the data on Table 1 is not commensurate with the claimed invention.

Declaration under 37 CFR 1.132 by Dr. Yoshihiko

7. The declaration under 37 CFR 1.132 filed 3/30/07 is insufficient to overcome the rejection of claims 1, 3-5, 7, 8, 10-22, 30-36, 41 and 42 based upon the rejection under 35

U.S.C. 103(a) as being unpatentable over Hori et al. (US 4,830,633) as set forth in the last Office action because: a) applicant's gel is applied to a non-woven fabric while the composition having a viscosity 155,000 mPa.s is in a bottle; b) a gel sheet having a range of viscosities, 500,000-20,000,000 is used and it is not clear how a single sheet has gel having viscosities ranging from 500,000-20,000,000 mPa.s. Further, the results are not commensurate in scope with the instant claims that are generic to the polymer and crosslinking agent.

No claim is allowed.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594. The examiner can normally be reached on 7 a.m. to 5:30 p.m. (Monday to Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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MICHAEL G. HARTLEY
SUPERVISORY PATENT EXAMINER